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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Benjamin J. Kwitek

Group Art Unit: 3711

Serial No.: 09/173,445

Examiner: Blau

Filed : 10/16/98

Title : GOLF GRIP

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DEC 28 2001
TC 3100 MAIL ROOM

REQUEST FOR RECONSIDERATION

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

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BOARD OF PATENT APPEALS
AND INTERFERENCES

On November 29, 2001, a Decision on Appeal was issued by the Board of Patent Appeals and Interferences in the above-referenced patent application. The Decision sustained the Examiner's rejection based upon the combination of three references to meet a single independent claim. As it is Applicant's opinion that the Decision does not fully appreciate the inventive nature of the claimed invention, Applicant respectfully requests reconsideration of the Decision.

Specifically, independent claim 21 was principally considered by the Board of Patent Appeals and Interferences in reaching their decision. Claim 21 defines a grip adapted for attachment to an implement including a handle. The grip includes a longitudinally extending tubular shell having an inner surface shaped and dimensioned for attachment to the handle of the implement. The tubular shell further includes an outer surface. The grip also includes a viscoelastic hand surface, having a thickness, secured about the outer surface of the tubular shell. The viscoelastic hand surface is a viscous liquid material contained within an elastomeric bag. The tubular shell includes a first end and a second end, as well as an outwardly extending first lip adjacent the first end of the tubular shell and an outwardly adjacent second lip adjacent the second end of the tubular shell. The first and second lips are shaped

and dimensioned to retain the elastomeric hand surface in position on the tubular shell.

In reaching a conclusion of obviousness, the Examiner has combined the teachings of U.S. Patent Nos. 5,322,290 to Minami, 5,555,584 to Moore, III et al. and 5,730,669 to Huang. With regard to the outstanding rejection, the issue for which Applicant requests reconsideration revolves around the obviousness of modifying the grip disclosed by Minami based upon the disclosure of Huang so as to include lips at both the upper and lower edges of Minami's grip. It is Applicant's opinion that no support exists for such a modification. In fact, the only support for such a modification, and the support utilized by both the Board and the Examiner in reaching their conclusion of obviousness, comes from the Applicant himself. As both the Board and the Examiner are certainly aware, suggestions proposed by the Applicant may not be utilized in reaching a conclusion of obviousness as they amount to impermissible hindsight.

In sustaining the Examiner's rejection based upon the combination of Minami, Huang and Moore, the Board stated:

In the specification of the Huang patent, there is no express disclosure of any particular purpose for lips 62 and 64. However, there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention, but rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art [citation omitted]. The obviousness issue must be looked at "through the eyes of one of ordinary skill in the art and what one would be presumed to know with that background." [citation omitted] In the present case, one of ordinary skill considering Huang's disclosure concerning Figures 11 to 14 would have known that lips 62, 64 serve at least two purposes: (1) they define the area around which the grip S is to be placed, and (2) they help to retain the grip S in position on the sleeve (shell) 60.

While the decision is correct in stating that the prior art need not expressly suggest the combination of known elements, the decision overlooks the equally known concept that one may not rely upon the teachings of the application at issue in arriving at a conclusion of obviousness; that is, one may not rely upon impermissible hindsight in reaching a conclusion of obviousness. This is exactly what

both the Examiner and the Board have done in maintaining the rejection of claim 21.

Specifically, neither Minami, Huang nor Moore consider the necessity or the usefulness of including lips at both the upper and lower end of a handle. In fact, neither Minami nor Moore disclose lips and Huang is entirely silent as to the function of the included lips. While both the Board and the Examiner look at Huang's silence as an invitation to reinvent the grip disclosed by Huang, the actual conclusion which should be drawn from Huang's silence is that the lips 62, 64 perform no particular function and one of skill in the art would similarly conclude the same. Specifically, the gripping surface disclosed by Huang is substantially rigid and there is no need for including lips 62, 64 to retain the grip material in position on the sleeve (the rigidity of the gripping material serves this function just fine). Similarly, and as to the suggestion that one would look to the lips as defining the area around which the grip material is to be placed, the grip material is applied to the grip of Huang presumably using highly automated mechanisms which do not require upper and lower positioned lips 62, 64 to identify the area around which the grip material is to be placed.

The suggestion that the lips are necessary for defining the area around which the grip material is to be placed presupposes a very, very low level of skill within the industry of golf club manufacture (of which those in the industry would likely be offended). With this in mind, Huang neither expressly nor implicitly provides a suggestion for modifying the grip of Minami to include the lips as defined by independent claim 21. In fact, Huang's silence regarding the lips 62, 64 suggests that they are unimportant and of no real value to those skilled in the art.

Thus, the two purposes set forth by the Board do not originate from the prior art at all. In fact, the prior art reference relied upon as teaching the claimed lips is silent and should only be applied for that which it fairly teaches. The reference should not be applied for that which the Examiner or the Board believes it could teach. If this were case, teachings of all kinds could be read into the prior art.

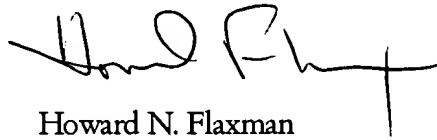
Similarly, neither Minami nor Moore disclose lips. In fact, both of these patents utilize viscous grip surfaces and provide no suggestion as to a need for either defining an area around which the grip material is to be placed or for retaining the grip material in position on a sleeve. The fact that both Minami and Moore disclose viscous grip surfaces, but fail to present any reasons for including retaining lips as defined in independent claim 21, is a clear indication of the unobviousness of the combination proposed in the outstanding rejection.

In fact, the only individual appreciating the necessity and usefulness of including lips to retain a viscoelastic gripping surface upon a tubular shell is Applicant himself. Given the prior art's failure to even remotely suggest the obviousness for the modification proposed in the outstanding Office Action, it can only be concluded that the rationale presented by both the Examiner and the present Decision comes from the innovations proposed by the present inventor and not from anywhere in the prior art. As such, the application of these teachings in reaching a conclusion of obviousness is improper as being based upon impermissible hindsight and Applicant respectfully requests reconsideration based upon the foregoing comments.

With regard to the other claims on appeal, they are believed to overcome the prior art of record for the reasons presented above with regard to independent claim 21.

It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicants' representative at the below number.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Howard N. Flaxman", with a long horizontal stroke extending to the right.

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Docket No. KWI-001